

REMARKS

Claim 16 is canceled. Claim 18 is amended to address the claim objection in the immediate prior office action. Applicant thanks the Examiner for identifying this oversight and requests this corrective claim amendment be entered pursuant to 37 CFR 1.116 (b)(1).

- Broadest Reasonable Interpretation of Claim 16

Applicant reiterates the Examiner's contentions on the meaning of claim 16 are in error. The complete context of the claim 16 limitation referenced by the Examiner is:

"[B]efore transfection, the genes are selectively altered, and following transfection with such selectively altered genes, the host microorganisms with characteristics best suited to commercial production of biosynthetic coal or biosynthetic petroleum are selected."

This is an additional process step of strain improvement, with the goal of commercial production in mind. A claim to strain optimization is not a claim to an industrial scale, economically competitive manufacturing process for biosynthetic petroleum. It is immediately apparent that this strain optimization process step would precede such manufacturing. Strictly for expediency in examination of the instant application, Applicant cancels claim 16 from the claim set to render the issue moot. Applicant respectfully requests the Examiner reconsider the claim interpretation advanced in the instant office action in view of the arguments and cancellation of claim 16 herein.

- Lack of Guidance in the Specification

Applicant notes much of the Examiner's contentions rest on what is and is not expressly reproduced in the Specification as if one of ordinary skill in the art were completely ignorant of any other relevant knowledge, or even of how to access such knowledge. This type of standard has been long ruled improper and is consequently contrary to USPTO guidelines. MPEP 2164.01 The Examiner alleges for example that the Specification has no guidance as to how one would identify genes within a differentially enriched DNA pool, the

expression of which contribute to biosynthetic petroleum production. Final Office Action issued 28 May 2009, page 4. For example, the Specification says nothing about how to qualitatively detect or quantitatively measure the biosynthetic petroleum products so produced. The art of petrochemical analytics was well developed as of Feb., 2003. See, e.g., Handbook of Petroleum Product Analysis, By: Speight, James G. © 2002, John Wiley & Sons; ISBN: 978-0-471-20346-9. For clarity of the nature of the instant rejection on appeal, Applicant respectfully requests the Examiner acknowledge (MPEP 2144.03(a)) or deny that the state of the art, as of the priority date, was sufficiently developed that one could indeed perform such petroleum analytical work without undue experimentation and without the need for Applicant to reproduce the contents of Handbook of Petroleum Product Analysis (409 pages) in the Specification.

In view of the above, applicant believes the pending application is in condition for allowance. Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 06-2375, under Order No. HO-P03493US0 from which the undersigned is authorized to draw.

Dated: 17 July 2009

Respectfully submitted,

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